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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/713,700      | 11/17/2003  | Jiao Gong            |                     | 2708             |

39066 7590 07/01/2005

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EXAMINER

TATE, CHRISTOPHER ROBIN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1655

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,700

Applicant(s)

GONG ET AL.

Examiner

Christopher R. Tate

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Specification*

The specification and drawings are objected to because of the following:

- The application is informal in the arrangement of the specification (see below for the preferred arrangement of the specification) and drawings (see below discussion on drawings).

As a whole, the specification and drawing are inconsistent with US Patent Office practice with respect to the language and layout thereof. As such, major modifications too numerous to individually mention are required. Examples include:

- The section of the specification entitled "Background of the Invention" typically should focus upon the invention and similar inventions, per se, not various court cases (court decisions are not deemed necessary or appropriate within the background information, as drafted).

- The specification also contains one or more embedded hyperlinks and/or other form of browser-executable codes (see, e.g., bottom of page 2). Applicant is required to delete the embedded hyperlinks and/or other form of browser-executable codes. See MPEP § 608.01.

- Numerous pages improperly contain the heading "Brief Description of the Drawing".

- There are numerous typos and grammatical errors throughout the specification and claims including the phrase "bombyx moriL". It appears that this phrase is attempting to define the silkworm scientifically known as --*Bombyx mori* (Linnaeus)--.

- A claim is what is used to actually define the invention. A claim is only permitted to be one sentence in length and must reasonably define and delineate the disclosed invention.

However, as drafted, the instant claim language fails to define and make clear what subject matter the claim encompasses with respect to adequately delineating its metes and bounds (also

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see USC 112, second paragraph rejection below). Please also note that terms such as "preventing" or "curing" various diseases/conditions often lead to enablement rejections and, in general, should be avoided within the claim language.

- The abstract should be a concise summary of the disclosed invention. The instant abstract, as a whole, fails to provide a concise summary of the disclosed invention. Further, phrases such as 'The reach of R.F. Furchgott and L.J. Ignarro which leads to the "NO theory" has shocked the whole world.' is not deemed necessary or appropriate to include therein.

- The Drawings all have the heading "Abstract of the Disclosure" which is improper and confusing. In addition, the drawings are inconsistent with U.S. Patent Office practice for various reasons including that they each recite "(attached table #)". Please note that each of the Tables and Figures should simply be labeled --Table #-- or --Figure #--, respectively, and the Brief description of each within the specification should correspond to these respective headings. Also (based upon an internal artifact sheet), it appears that color drawings may have been filed with the instant application. If so, they must be referred to in the specification. In addition, please note the following: Color photographs and color drawings are not accepted unless a petition filed under 37 CFR 1.84(a)(2) is granted. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings and black and white photographs have been satisfied. See 37 CFR 1.84(b)(2).

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- As mentioned above, the application is informal in the arrangement of the specification.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet) -each one sentence in length.
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The claim recited on page 25 of the instant specification is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As drafted, it is completely unclear as to what is actually being claimed for reasons too numerous to individually mention. Examples of the indefiniteness of the claimed invention include the following:

- It is unclear by the first sentence within the claim language as to what is being defined since the sentence is narrative in nature and fails to recite any actual limitations therein.
- It is unclear if any or all of the recitations following the first sentence on page 25 are also attempting to define the instantly claimed/disclosed invention. Further, many (most) of these recitations are also narrative in nature and, thus, fail to define actual limitations therein.
- Abbreviations in the first instance of claims should be expanded upon with the abbreviation indicated in parentheses. The abbreviations can be used thereafter.

Please note that the language of the claims must make it clear what subject matter the claims encompass to adequately delineate their "metes and bounds". See, e.g., the following decisions: **In re Hammack**, 427 F 2d. 1378, 1382, 166 USPQ 204, 208 (CCPA 1970); **In re Venezia** 530 F 2d. 956, 958, 189 USPQ 149, 151 (CCPA 1976); **In re Goffe**, 526 F 2d. 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); **In re Watson**, 517 F 2d. 465, 477, 186 USPQ 11, 20 (CCPA 1975); **In re Knowlton** 481 F 2d. 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). The courts have also indicated that before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover. See, e.g., the following decisions: **In re Steele**, 305 F 2d. 859, 134 USPQ 292 (CCPA 1962); **In re Moore** 439 F 2d. 1232, 169 USPQ 236 (CCPA 1969); **In re Merat**, 519 F 2d. 1390, 186 USPQ 471 (CCPA 1975).

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As drafted, the claimed invention is essentially unsearchable. However, an attempt was made by the Examiner to search the claimed invention insofar as it reads upon a composition comprising *Bombyx mori* (Linn.) therein. See the art rejection below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The claimed invention (e.g., based upon the first sentence within the claim language set forth on page 25 of the instant specification) is rejected under 35 U.S.C. 102(b) as being anticipated by Lee (KR 2001113408 - DWPI abstract).

Lee teaches a composition (for improving impotency and blood circulation) comprising *Bombyx mori* (Linn.) and various herbals therein (see DWPI English abstract).

Therefore, the reference is deemed to anticipate the instantly claimed invention, as drafted.

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An examination of this application reveals that Applicants are unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicants are advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450.

It is suggested that (with the aid of an attorney) the claimed invention be particularly defined by - e.g., via claiming a product comprising *Bombyx mori* (Linn.) and the 13 other instantly disclosed essential herbal components therein (within an independent claim). Methods of making and/or using the composition (of the same scope) could also be presented within other claims.

### **Conclusion**

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher R. Tate  
Primary Examiner  
Art Unit 1654